

REMARKS

Reconsideration and removal of the grounds for rejection are respectfully requested.

Claims 16-32 were in the application, claims 16, 20, 23, 25, 26, 29 and 30 have been amended, and claims 17 and 19 have been cancelled.

Entry of this amendment after final is respectfully requested as placing the application in condition for allowance and/or reducing the issues on appeal. Entry is proper in accordance with MPEP 714.12:

“Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered. Also, amendments filed after a final rejection, but before or on the date of filing an appeal, complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(b)”

By this amendment, claims 16 has been combined with claims 17 and 19, placing claim 19 in independent form. Claims 20, 23, 25, 26, 29 and 30 have been amended to correct the errors pointed out by the examiner, typographical errors and to correct the claim dependency. No new matter is involved in this amendment.

No new search nor new issues are raised by this amendment, and such clarifications and corrections are believed to render moot the rejections under 35 USC 112, second paragraph. Consequently, entry of this amendment will resolve this issue.

Claims 29 and 30 were objected to as being in improper form. The amendment of these claims renders moot the objection.

Claims 16-17, 21-30 and 32 were rejected as being anticipated by Mohaht et al. By the amendment to claim 16, placing claim 19 into independent form, this rejection has been rendered moot, reducing the issues on appeal.

Claims 18-20 and 31 were rejected as being obvious over Mohaht et al, U.S. Patent no. 4,915,013.

To establish a prima facie case of obviousness, there should be some teaching,

suggestion or motivation in the prior art to make the specific claimed combination that was made by the applicant. In re Raynes, 7 F.3d 1037, 1039, 28 U.S.P.Q.2D (BNA) 1630, 1631 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D (BNA) 1443, 1445 (Fed. Cir. 1992). However, the search for a teaching or suggestion should not be rigid, and a more flexible approach to a determination of obviousness should be used so as to avoid conflict with common sense. *KSR International Co. v. Teleflex Inc. et al*, 2007 U.S. Lexis 4745 U.S. Supreme Court, April 30, 2007. The Supreme Court reaffirmed that obviousness can not be established by a hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18 U.S.P.Q.2D (BNA) 1885, 1888 (Fed. Cir. 1991). It is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

The applicants' invention provides single trigger control, allowing a user to switch from a single hit, to automatic, using the same trigger. This switching mechanism is provided using the combination of four valve means identified in claim 1, integrated so as to be responsive to operation of a single trigger pull, with an intermediate position switching the mode. Thus, a user does not have to stop and operate a separate switch to switch between modes. In particular, there is positive feedback to the user provided when activating the automatic mode, as the trigger must additionally overcome the biasing force of the elastic means 13 which engage the fourth valve means.

Mohaht has a system for converting from the single shot mode to the continuous shot mode using a vertical pin (threaded sleeve) 100 inside of which is housed a sealing element 101. In the present application, conversion from the single shot mode to the continuous shots mode is accomplished using the horizontal pin 4. While both systems rely on trigger movement, in the presently claimed invention, using manual force to act slightly onto the trigger provides a single shot. To achieve the continuous mode, more manual force is required to act strongly onto the trigger, to overcome the biasing force of the elastic means 13.

In Mohaht, the single shot mode requires manual force to overcome the helical spring pressure, the spring acting on the trigger by means of the pin 60. The change to continuous shot mode occurs when the sealing element 101, fixed to the trigger 26 by means of the screw 100, is able to occlude the hole 102 with its pointed end 105. The result is that there is no tactile signal which alerts the operator of the passage from the single shot mode to the continuous shot mode.

In the present invention, the pin 2 is moved by the trigger 7, with no biasing, so there is no force to overcome, providing a clear delineation to the operator when the switch is desired to be made from single shot mode to continuous mode, a larger pressure required on the trigger 7 to switch to the continuous shot mode, because only then does the spring 13 come into play.

This difference is significant as it provides much more sensitivity to the operator, so that pulling the trigger with a minimum of effort, as there is no spring force to overcome is readily distinguished from when the trigger must be further depressed, to switch over to continuous mode, because of the higher resistance of the trigger to movement because of the spring.

The Mohaht patent does not provide the same tactile perception of the limit between the two trigger positions. In the single shot mode, in Mohaht, the pin 60, pressed by the trigger 26, allows the opening/closing of the various channels of the system generating a single shot, with yet the collateral effect of maintaining open the hole 102, with subsequent exhaust of fluid under the pressure by the system, that is, with a consequent air losses.

In the present invention, the pin 2, pressed by the trigger 7, allows the opening of the various channels of the system which generates as well a single shot, but without any air losses, because the system is closed and the air passes from a space to another without dispersion. This difference provides lower air consumption and a greater reliability because, the system being closed, air is not lost in the same way in the various working phases.

There is nothing within Mohaht that teaches or suggests the particular arrangement of components as provided by the present invention, and any proposed modifications to achieve the present invention comprise a clear hindsight reconstruction. Consequently, claims 16, 18, 20 and 31 are not rendered obvious over Mohaht.

Claims 16-32 were rejected as being obvious over U.S. Patent 3,547,003 to Ramspeck. The discussion above has some relevance to this rejection as well. There are substantial differences between the present invention and Ramspeck.

In Ramspeck, to change from a single shot mode to a continuous shot mode, there must be a force applied to the pin 174, which, if moved towards one direction, generates a single shot, but if moved towards another direction, generates the continuous shot mode. In both cases, there must be an action on the pin 174, and then on the trigger 98, in order to obtain a single shot or continuous shots, Ramspeck requiring using two fingers.

In the present invention, the entire system works with movement in a single, natural direction, using a single trigger 7, and acting with light force or heavy force determining whether the operator wants to proceed with single shots or continuous shots. This means that only a single finger, acting on a single trigger is all that is needed with the presently claimed invention.

Ramspeck has only three valves. Ramspeck fails to teach or suggest to one skilled in the art the use of a fourth valve, and also fails to teach or suggest the provision of elastic means associated with this fourth valve to provide a clear tactile distinction when switching modes. On the contrary, one skilled in the art would be led away from the applicants' invention, believing that the three valve system is adequate, and find no motivation to add another valve and spring which would increase the complexity of the device. Absent such a teaching, suggestion or motivation, one skilled in the art would not find the claimed invention obvious over Ramspeck, and the rejection of claims 16-32 should be withdrawn.

Based on the above amendments and remarks, favorable consideration and allowance of the application are respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

_____/WJS_____

COLEMAN SUDOL SAPONE, P.C.
714 Colorado Avenue
Bridgeport, Connecticut 06605-1601
Telephone No. (203) 366-3560
Facsimile No. (203) 335-6779

William J. Sapone
Registration No. 32,518
Attorney for Applicant(s)